

Docket No.: 5486-0129PUS1  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

---

In re Patent Application of:  
Darryl E. RUBIN et al.

Application No.: 09/768,813

Confirmation No.: 1317

Filed: January 25, 2001

Art Unit: 2626

For: ANNOTATING ELECTRONIC  
INFORMATION WITH AUDIO CLIPS

---

Examiner: J.R. Jackson

**REQUEST FOR A PRE-APPEAL BRIEF CONFERENCE**

March 30, 2007

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**INTRODUCTORY COMMENTS**

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached five (5) sheets.

### ARGUMENTS

Initially, Applicants thank the Examiner for granting a personal interview with the Applicants' representative on February 15, 2007. No agreement was reached during the interview. Applicants respectfully submit that the Examiner has made the following clear error:

The Examiner is improperly interpreting and applying the prior art in rejecting independent claims 27, 33, 43, 50, 55, 70, 73, 75, 77, 83, and 85 under 35 U.S.C. § 102(e) as being anticipated by US 6,279,014 to Schilit et al. ("Schilit").

The Examiner is also improperly interpreting and applying the prior art in rejecting independent claims 1 and 10 under 35 U.S.C. §103(a) as being unpatentable over US 5,390,138 to Milne et al. ("Milne") in view Schilit.

1. Schilit fails to teach or suggest associating an audio annotation and/or audio note with an author of the audio annotation and/or audio note:

In order to reject a claim under 35 U.S.C. § 102(e), each and every element of the claim must be described in the reference. The Office Action alleges that Schilit discloses all of the elements of independent claims 27, 33, 43, 50, 55, 70, 73, 75, 77, 83, and 85. Each of these independent claims includes some type of association between an audio annotation and/or audio note with an author of the audio annotation and/or audio note.

Specifically, claim 27, recites, among other features, "wherein said audio annotation is associated with an author of said audio annotation." Applicants' independent claim 33 recites, among other features, a step of "associating an author of the audio annotation with the audio annotation." Independent claim 43 recites, among other features, "retrieving audio annotations, each of said audio annotations being associated with an author of said audio annotation." Applicants' independent claim 50 recites, among other features, "wherein said at least one audio annotation is associated with a property identifying an author of said at least one audio annotation." Independent claims 55 and 70 each recite, among other features, "wherein said audio content includes at least one audio annotation, wherein at least one property identifies an author of the at least one audio annotation." Applicants' independent claim 73 recites, among other features, "wherein each of said audio clips includes an audio annotation associated with an author of the audio annotation, wherein said search terms or properties identify an author of the

audio annotation." Independent claim 75 recites, among other features, "wherein each of said audio clips includes an audio annotation associated with an author of the audio annotation, wherein said processing associates an author of the recorded audio signal with the audio annotation." Applicants' independent claim 77 recites, among other features, "associating an author of said audio note with said audio note," and Applicants' independent claim 83 recites, among other features, "wherein each audio note is associated with a property identifying an author of said audio note." Finally, Applicants' independent claim 85 recites, among other features, "wherein each set of audio notes is associated with a property identifying an author of said set of audio notes."

Shilit neither teaches nor suggests any type of association between an author of an audio annotation and/or audio note and the audio annotation and/or the audio note. Column 5, lines 42-64 of Shilit describe the manner in which the Shilit system assigns attributes. Particularly, Shilit discloses that attributes to the annotations are assigned in at least one of three ways: 1) attributes entered by the user; 2) attributes inherited from the document's attributes; and 3) implicit or explicit attributes derived from the annotations themselves. Although Shilit discloses that a user may enter attributes, which may be derived from the annotations themselves including "agree", "disagree", "good idea", and "follow-up", there is no disclosure that the user can be identified or associated with the annotations. Shilit merely discloses that "attributes may also be entered implicitly, the most important of which is the date and time that the annotation was made and the page number at the annotation (col. 5, lines 56-59)." Again, there is no mention that an author of the annotations are identified or associated with the annotations as required by the above-identified independent claims. Applicants respectfully submit that the cited portion of Shilit fails to teach or suggest that an attribute may be **an author of an audio annotation and/or an audio note.** Specifically, the cited portion of Shilit references an author as an attribute **only with respect to the original document itself.** "Attributes may also be inferred from documents. In the system 10, the electronic documents are already associated with a variety of attributes, such as creation date, author, province and title." Shilit fails to describe association of an author with an audio annotation and/or audio note. As such, for at least these reasons, independent claims 27, 33, 43, 50, 55, 70, 73, 75, 77, 83, and 85 are patentably distinct from

Shilit.

2. The combination of Milne and Schilit fails to teach or suggest associating an audio annotation with an author of the audio annotation:

Applicants' independent claim 1 recites, among other features, "wherein said processor further associates an author of each of said audio annotations with each of said respective audio annotations." Independent claim 10 recites, among other features, "each of said audio annotations including an author of said audio annotation and being associated with said displayed electronic information." As admitted by the Office Action, Milne fails to teach or suggest the above-identified claim feature. (See Office Action, pages 14 and 16). In response, the Office Action relies on Shilit to describe this feature. This feature of Applicants' claims 1 and 10 is similar to one or more features recited in Applicants' independent claim 27. As demonstrated above, Shilit fails to teach or suggest association of an author of an audio annotation with the audio annotation. As such, for similar reasons as recited above with respect to claim 27, Shilit fails to teach or suggest the above-identified claim feature of independent claims 1 and 10.

Dependent claims 2, 4-9, 11, 13-26, 28-32, 34-42, 44-49, 51-54, 56-58, 60-69, 71-72, 74, 76, 78-82, 84, and 86 are at least allowable by virtue of their dependency on corresponding independent claims. None of Headley, Aihara, Hou, Dwyer, Milne, Pritt, Jain, Hurtado, Martin, Kessenich, or Miller, overcomes the deficiencies of Shilit as described with reference to independent claims 1, 10, 27, 33, 43, 50, 55, 7.3, 75, and 77.

**CONCLUSION**

In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.


Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Ali M. Imam, Reg. No. 58,755 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 09/768,813  
Docket No.: 5486-0129PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: March 30, 2007

Respectfully submitted,

By  #58,755  
Michael R. Cammarata  
Registration No.: 39,491  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicant